

### **III. Remarks**

Claims 12-30 were previously pending. Claims 22-30 are hereby canceled without prejudice to or disclaimer of the subject matter therein. New claims 31-39 have been added. Applicants request reconsideration of pending claims 12-21 and 31-39 in light of the above amendments and the following remarks.

#### **§102 Rejections**

**Claims 22, 23, 28, and 30** stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0039384 A1 to Boehm, Jr. et al. (“the Boehm application”) and under 35 U.S.C. § 102(a) as being anticipated by EP 1222900 to Nohara et al. (“the Nohara patent”). Each of these claims is canceled by the present paper. Accordingly, these rejections are moot and will not be addressed in detail.

#### **§103 Rejections**

**Claims 12-15, 17, 20-24, and 26-30** stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,964,665 to Thomas et al. (“the Thomas patent”) in view of U.S. Patent No. 4,554,914 to Kapp et al. (“the Kapp patent”). Claims 22-24 and 26-30 are canceled by the present paper.

The PTO provides in MPEP §2131 that

“The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.”

The Examiner clearly cannot, using the Thomas and Kapp patents, establish a prima facie case of obviousness in connection to claims 12-15, 17, and 20-21 for at least the following reasons.

35 U.S.C. §103(a) provides, in part, that:

“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the

invention was made to a person having ordinary skill in the art . . .”  
(emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

However, even when combined the Thomas and Kapp patents at least fail to disclose several recited elements of independent claim 12. In particular, the Thomas and Kapp patents at least fail to disclose “laterally inserting a first insertion member into a sidewall of the first vertebra such that the first insertion member does not extend within the intervertebral space” and “laterally inserting a second insertion member into a sidewall of the second vertebra.” Rather, the Thomas patent discloses that “a cannulated pedicle screw 12 according to the invention would be placed into the left and right pedicle 56 of the individual vertebra 52.” Col. 6, Lines 21-23. The Thomas patent neither discloses laterally inserting the pedicle screw 12 or inserting into the sidewall of a vertebra as required. Similarly, the Kapp patent also fails to teach such limitations. Accordingly, even when combined the Thomas and Kapp patents fail to disclose these limitations of independent claim 12.

Further, the Thomas and Kapp patents at least fail to disclose “applying a rotating force to the connecting member from a substantially lateral approach to rotate the first and second vertebrae relative to one another to reduce the spondylosed relationship therebetween” as recited in claim 12. The Thomas patent simply does not disclose applying a rotating force to rods 50 to rotate the vertebrae relative to one another as asserted in the Office Action. Rather, the Thomas patent explicitly states that “[t]he alignment rods 10 are [] used to manipulate and align the vertebral body 52 to the desired angle and position ... the surgeon would ... pull or push the vertebral body to correct spondylolisthesis ... **Once the surgeon has manipulated the vertebral bodies into the proper, or desired, alignment,** the fixation hardware is slipped down the shaft of the alignment rod 10.” Col. 6, Lines 37-67 (emphasis added). In addition, the Thomas patent fails to disclose applying a rotating force from a substantially lateral approach as required. Consistent with the drawings of the Thomas patent and the corresponding description explaining that a surgeon would “pull or push the vertebral body to correct spondylolisthesis,” it is clear that the Thomas patent discloses only a substantially posterior approach to correcting

sponylolisthesis. The Thomas patent clearly does not disclose the substantially lateral approach as required. Similarly, the Kapp patent also fails to teach such limitations.

Accordingly, for at least these reasons even when combined the Thomas and Kapp patents fail to disclose all of the recited elements of independent claim 12 and, therefore, claims 13-15, 17, 20, and 21 that depend from and further limit claim 12. Thus, for at least these reasons Applicants request that the §103 rejection of claims 12-15, 17, 20, and 21 over the Thomas and Kapp patents be withdrawn.

**Claims 18 and 19** stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Thomas patent in view of the Kapp patent as applied to claim 17, in further view of U.S. Patent No. 6,030,389 to Wagner et al. (“the Wagner patent”). However, as discussed above even when combined the Thomas and Kapp patents fail to disclose all of the recited elements of claim 12 from which claims 18 and 19 depend. The Wagner patent does not affect this deficiency. Accordingly, for at least the same reasons the Thomas, Kapp, and Wagner patents fail to disclose all of the limitations of claims 18 and 19. Therefore, Applicants request that the §103 rejection of claims 18 and 19 over the Thomas, Kapp, and Wagner patents be withdrawn.

**Claims 14-16 and 25** stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Thomas patent in view of the Kapp patent as applied to claim 13 and 24, in further view of U.S. Patent No. 5,314,477 to Marnay (“the Marnay patent”). Claim 25 has been canceled by the present paper. As discussed above, even when combined the Thomas and Kapp patents fail to disclose all of the recited elements of claim 12 from which claims 14-16 depend. The Marnay patent does not affect this deficiency. Accordingly, for at least the same reasons the Thomas, Kapp, and Marnay patents fail to disclose all of the limitations of claims 14-16. Therefore, Applicants request that the §103 rejection of claims 14-16 over the Thomas, Kapp, and Marnay patents be withdrawn.

### **New Claims**

New claims 31-39 appear to be patentable over the cited references because each of the claims recites one or more elements that are not disclosed or suggested in the cited references. For example, new independent claim 31 requires:

A method of correcting spondylolisthesis comprising:  
removing an intervertebral disc between a first vertebra and a second vertebra to form an intervertebral space, the first and second vertebrae being in a spondylosed relationship;  
laterally inserting a first insertion member into a sidewall of the first vertebra such that the first insertion member does not extend within the intervertebral space;  
laterally inserting a second insertion member into a sidewall of the second vertebra such that the second insertion member does not extend within the intervertebral space;  
positioning an elongated member adjacent to and between the first and second insertion members;  
engaging the elongated member with the first and second insertion members;  
applying a rotating force to the elongated member from a lateral approach to rotate the first and second vertebrae relative to one another to reduce the spondylosed relationship therebetween;  
and  
inserting an implant between the first vertebra and the second vertebra to substantially maintain the reduction of the spondylosed relationship.

Claims 32-39 depend from and further limit claim 31. Accordingly, Applicants request a notice of allowance for claims 31-39.

#### IV. Conclusion

It is believed that all matters set forth in the Office Action have been addressed and that all pending claims are in condition for allowance. Accordingly, Applicants request an indication of allowance of the pending claims. If an interview would expedite prosecution in any way, the Examiner is invited to contact the Applicants' undersigned representative.

Respectfully submitted,

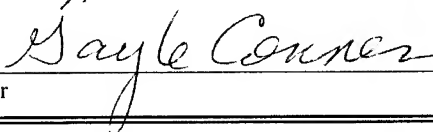


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